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Claim 19, line 3, change "; and" to --, operably linked to--.

REMARKS

Reconsideration of this application and entry of the foregoing amendments are respectfully requested.

The claims have been revised so as to additionally define the subject invention and so as to additionally distinguish the invention over the art of record. Applicant reserves the right to pursue any subject matter deleted here in a continuation application.

Various claims of this application stand provisionally rejected over claims of Application No. 07/538,372. These rejections have been rendered moot by the abandonment of the parent case in favor of this application.

Claims 1-3, 11-16 and 19-21 stand rejected under 35 U.S.C. 101 as the claimed invention allegedly lacks patentable utility. Withdrawal of the rejection is believed to be in order in view of the above claim amendments and further in view of the comments that follow.

At the outset, it is noted that the claims as now presented are drawn to a DNA sequence encoding GDF-1 or UOG-1.

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Accordingly, the Examiner's comments relating to the utility of portions of those sequences are rendered moot.

As to the utility of the sequences encoding GDF-1 and UOG-1, the Examiner is reminded that if an asserted utility of a compound is believable on its face to those skilled in the art, then the burden is on the Examiner to give adequate support for a rejection based on lack of utility. It is incredible statements or statements unlikely to be correct that require adequate proof by an applicant.

It is respectfully submitted that the Examiner's comments do not adequately support the rejection. All that the Examiner in fact points to is a lack of actual proof. As noted above, however, such proof should not be required, absent incredible statements or statements deemed unlikely to be correct. Applicant's statements of utility are quite credible. Similarity of sequence is sound basis for the asserted utility. Accordingly, nothing more should be required.

Reconsideration is requested.

Claims 1-3 and 11-15 stand rejected under 35 U.S.C. 102 as anticipated by Derynck et al. Claims 1-2 and 11 stand rejected as anticipated by Weeks et al. Claims 1-3 and 11-15 stand rejected as anticipated by Wang et al. Withdrawal of these rejections is in order in view of the above-noted amendments

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which delete the references to "portions". Reconsideration is requested.

Claims 1-3, 11-16 and 19-21 stand rejected under 35 U.S.C. 112, first paragraph. Withdrawal of the rejection is in order for the reasons that follow.

Much of the Examiner's argument appears to be based on the prior inclusion in the claims of "portions" of the disclosed sequences. The Examiner's concerns, in that regard, are rendered moot by the above-noted revisions of the claims.

As to the Examiner's comments regarding the allegedly insufficient disclosure relating to how to use the invention, attention is directed to the foregoing comments offered in response to the Examiner's rejection under 35 U.S.C. 101. It is submitted that the alleged lack of proof of utility in no way means that the disclosure is inadequate to teach one how to use the invention for the stated purpose. The Examiner is requested to indicate what further disclosure would be required by one skilled in the art, or withdraw the rejection.

The Examiner's comments with respect to claims 15 and 21 are not understood. The Examiner appears to be focussed on what experiments may or may not have been actually carried out rather than on whether the invention claimed could be practiced based on the disclosure presented. It is submitted that in fact

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the disclosure is quite adequate and the Examiner is requested to provide evidence or sound reasoning inconsistent with the disclosure to support the rejection of the claims as non-enabled, or withdraw the rejection.

Reconsideration is requested.

Claims 2, 11, 15 and 19 stand rejected under 35 U.S.C. 112, second paragraph. Withdrawal of the rejection is in order in view of the above amendments and for the reasons that follow.

The Examiner's objection to claim 2 is believed to have been overcome by the above claim revisions. The above revisions are also believed to overcome the rejections of claims 11 and 19.

The rejection of claim 15 is not well founded. Antecedent basis for the term "segment" is found in claim 11, as the Examiner notes.

Reconsideration is requested.

In objecting to the specification, the Examiner appears to have overlooked the fact that the original claims form part of the disclosure. Should the Examiner request, the specific claim language can be introduced into the specification by amendment; however, such is not seen to be necessary. Withdrawal of the objection is requested.

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This application is submitted to be in condition for allowance and a Notice to that effect is requested.

Respectfully submitted,  
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